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OFFICE OF PETITIONS

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| In re Application of | : |
| Dryja et al. | : |
| Application No. 09/144,897 | : Petition for |
| Filing Date: September 1, 1998 | : Patent Term Extension |
| U.S. Patent No. 7,376,453 | : |
| For: Signal Processing Apparatus | : |

The above-identified application has been forwarded to the undersigned for consideration on a petition entitled "Supplemental Petition under 37 CFR 1.181 for Correction of Patent Term Extension," received on June 30, 2008. The petition is being treated as a petition under 37 CFR 1.181 and 37 CFR 1.701, and as a petition under 37 CFR 1.182, since 37 CFR 1.701 does not provide for patent term extension for delays that occur due to a suspension for a potential interference.

The petition under 37 CFR 1.181 is granted-in-part.

The petition received under 37 CFR 1.182 is dismissed.

Background

Petitioner notes that the above-identified application was filed on September 1, 1998, and allowed on January 10, 2008, but issuance was delayed due to two suspensions in prosecution for a potential interference and delayed due to an interference proceeding. Petitioner states that the USPTO failed to provide patent term extension for the two suspensions in prosecution initiated by the Examiner and for the period of the interference, which occurred after the decision by the BPAI. Petition asserts that since these time periods were not included in the patent term extension calculation, that the 130 days of patent term extension in the Notice of Allowance and Issue Fee Due is incorrect.

Petitioner asserts that the application was suspended for two periods, the first period beginning on July 2, 2003 and ending on January 2, 2004, and the second period beginning on May 16, 2006 and ending August 16, 2006. Petitioner argues that the patent is eligible for **247 days** of patent term extension for the above periods of extension which partially overlap with the eventual interference under 37 CFR 1.701(c)(1).

Petitioner states that an interference was declared on July 18, 2006. Petitioner states that the date of judgement of the interference is November 24, 2008. Petitioner states that the patent was delayed for **130 days** due to the interference pursuant to 37 CFR 1.701.

Petitioner contends that after the decision November 24, 2006, the BPAI failed to forward the application back to the examiner until December 21, 2007 thus causing further delay. Petitioner contends that the patent should be adjusted by an additional **393 days** due to the delay. Petitioner contends that the interference was not “terminated” within the meaning of the rule until the BPAI forwarded the application to the Examiner for review. Petitioner asserts that the intent of 37 CFR 1.701 is to allow for patent term extension for delay caused by interference proceedings which would include any delay caused by the BPAI in dispatching the case back to the Examiner.

Petitioner asserts that the period of extension under 37 CFR 1.701 should be 770 day (247 + 130 + 393) due to delays by the Office.

On September 1, 1998, the above identified application was received by the Office.

On July 2, 2003, a first Letter of Suspension was mailed by the Office.

On May 16, 2006, a second Letter of Suspension was mailed by the Office.

On July 18, 2006, a Declaration of Interference was mailed by the Office.

On November 24, 2006, a judgment was made, by a decision mailed by the Board of Patent Appeals and Interferences.

On January 10, 2008, a Notice of Allowance and Fee Due notice was mailed by the Office.

Decision

The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154. 35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in utility and plant applications filed on or after June 8, 1995, and, as amended by the “American Inventors Protection Act of 1999,” enacted November 29, 1999, as part of Public Law 106-113, for other specifically defined administrative delays in utility and plant applications filed on or after May 29, 2000.

The above-identified application was filed on September 1, 1998. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner asserts that under 37 CFR 1.701(c)(1)(ii); the patent term extension should be 246 days for the delays due to the suspensions in prosecution due to an interference. In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(c)(1), which, consistent with the statute, requires an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension. Although prosecution was twice suspended in the above-identified application, the suspensions were due to a potential interference either with or involving one or more other applications. The suspensions were not for the reason that the subject application was involved in an interference, or to await the result of an interference proceeding in another application. As a result, the provisions of 37 CFR 1.701(c)(1)(ii) do not apply because this section applies to suspensions by the "Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application," and in this instance there were no such other interference proceedings. Therefore, Petitioner's argument that he is entitled to an additional 246 days of patent term extension for the periods of the two suspensions under 37 CFR 1.701(c)(1)(ii) is not persuasive. The application is entitled to zero (0) days of patent term extension under 37 CFR 1.701(c)(1)(ii).

According to 37 CFR 1.701(c)(1)(i), the application is entitled to patent term extension for the number of days, in the period beginning on the date the interference was declared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. The interference was declared on July 18, 2006, the date of the Declaration of Interference. A final decision was entered on November 24, 2006, the date of the decision by the Board of Patent Appeals and Interferences. According to 37 CFR 41.205, after a final decision by the Board is entered, interference is considered terminated when no appeal or other review has been or can be taken. As a result, the period of extension is 191 days, the period from July 18, 2006, the date of the declaration of interference to January 24, 2007, which is two months after the mailing of the decision by the Board including the beginning and end dates.

While Petitioner argues that additional patent term extension should be granted because the interference was not terminated until December 21, 2007, the date the application was dispatched to the Examiner, as the Board still had jurisdiction. The interference was terminated two months after the mail date of the decision by the Board, and when no further appeal was taken. After the Board entered the final decision, there were no further interference proceedings with respect to the application, thus the application is not entitled to additional patent term extension.

The delay in issuance of petitioner's patent is regretted. However, the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The Office proposes to issue a certificate of correction in order to rectify the error regarding the patent term extension information. See 35 U.S.C. 254 and 37 CFR 1.322. Applicant is given THIRTY (30) DAYS to respond to this letter. If no objection is received from applicant, the Office will issue a certificate of correction indicating that the patent term is extended for 191 days under 35 U.S.C. 154(b). This time limit is NOT extendible under 37 CFR 1.136.

The Office's electronic record (Patent Application and Location Monitoring system (PALM)) has been adjusted to show that 191 days of patent term extension has been accrued to the above-identified application.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized the \$400 fee for the petition under 37 CFR 1.182 has been charged to Petitioners Deposit Account (11-1410).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

A handwritten signature in black ink, appearing to read 'M. O. Polutta', with a stylized flourish at the end.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Appl. No. : 09/144,897
Filed : September 1, 1998

dated May 16, 2006, respectively. Because the application was "suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a)" per 37 C.F.R. § 1.701(c)(1)(ii), Applicants submit that the patent term extension should be adjusted to reflect the appropriate 247 delay.

Applicants submit that the entire 184 day delay due to the first suspension should be added to the patent term extension. The second suspension overlapped with the amount of delay due to the eventual interference involving the present application and Applicant submits that, under 37 C.F.R. § 1.701(c), the non-overlapping period of 63 days should also be added to the patent term extension. As such, Applicants submit that the requested additional 247 days reflect the cumulative total of the first suspension and the non-overlapping portion of the second suspension, and should be added to the patent term extension.

Summary

Applicants submit that the present application was delayed by at least 393 days in addition to the indicated 130 days due to an interference proceeding in which the application was involved. Moreover, the present application was delayed by 247 days due to suspension of prosecution of the application due to interference proceedings. As such, the Applicants submit that the patent term extension should reflect the cumulative total of 770 days of delay due to interference proceedings pursuant to 37 C.F.R. § 1.701, not the indicated 130 days of delay, and request that the patent term extension be corrected to reflect at least this 770 day amount.

No fee is deemed due under 37 C.F.R § 1.181 as neither 37 C.F.R. § 1.181 nor 37 C.F.R. §1.701 indicate that a fee is due in conjunction with a Petition under 37 C.F.R §1.181. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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